

REMARKS

Upon entry of the new claim, claims 1-30, 46-59 and 71 will be pending in the above-identified application. New claim 71 has been added, as set forth in the above listing of the claims. The amendments are supported throughout the specification, including, for example at pages 7-8. As such, no new matter has been added by these amendments. Applicants further point out that Final rejection is premature, as set forth below. As such, entry of the new claim is respectfully requested.

Regarding Final Rejection

Applicants initially submit that final rejection is premature and inappropriate because the Examiner has made a new ground of rejection, which was not necessitated by a previous amendment by the Applicant and Applicant has not previously been afforded an opportunity to address this new rejection.

In particular, the Examiner has, for the first time, rejected claims 1-5 and 12-13 as allegedly being obvious in view of the specific combination of references of DeBruin-Ashton and Falchuk, in further view of Tawil. While claims 1 and 14 were amended in Applicants response mailed 9/8/2005, the amendments consisted of merely clarifying, in response to the Examiner's rejection of the claims under 35 U.S.C. §101, that the claimed methods utilized the technological arts and, therefore, were directed to statutory subject matter. As is known by the Examiner, Final rejection on a second of subsequent action on the merits is improper where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) (see MPEP 706.07(a)).

Accordingly, Applicants submit that final rejection is premature and respectfully request withdrawal of the finality of the rejection.

Claims rejections under 35 U.S.C. §103

Claims 1-5 and 12-13 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1), and further in view of Tawil (U.S. 5,225,976).

Regardless of the inappropriate finality of the new rejection, Applicant points out that the Examiner has cited no real suggestion or motivation to combine the cited references and, even if combined, the cited references, taken either alone or in combination, would fail to teach each and every element of the claimed invention, thereby precluding *prima facie* obviousness. See, e.g., MPEP § 2143.

Applicant respectfully disagrees with the Examiner's characterization of DeBruin-Ashton. DeBruin-Ashton teaches selecting physicians based on broad specialty categories and then reducing the number of physicians originally selected in order to present a more manageable list to a customer. However, the only reduction methods taught by DeBruin-Ashton include a) randomly removing physicians from a list; and b) listing physicians new to a health care plan in higher proportion (see, DeBruin-Ashton col. 12, lines 37-54).

DeBruin-Ashton fails to teach at least the steps of a) certifying a group of practitioners to perform a medical procedure; b) accessing an electronic database having information comprising a number of procedures performed by each of the group of certified practitioners; and c) providing to the identified patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list, as recited in claim 1.

Applicant further submits that Falchuk fails to teach certifying a group of practitioners to perform a medical procedure, as alleged by the Examiner. As previously submitted, Falchuk teaches a system for facilitating consultation between a primary care physician and a specialist, and reporting such consultation to an accreditation authority for awarding continuing medical education (CME) credits. Nowhere does Falchuk teach certifying a group of practitioners to perform a medical procedure.

The Examiner has dismissed Applicant's previous remarks pointing out distinctions between the teachings of Falchuk and the method of claim 1, but essentially only repeated argument from the previous Office action without really addressing Applicant's remarks. Applicant believes that the Examiner has failed to establish that the "certifying" element of claim 1 is taught in the art and, therefore, failed meet the Office's burden in establishing *prima facie* obviousness at least for this reason.

Tawil is cited by the Examiner as teaching "tracking the number of times the provider has performed the procedure" (see Final Office Action, page 3). In addressing Applicants previous remarks regarding the teachings of Tawil, the Examiner references "the purpose" of the system of Tawil (Final Office Action, page 10). Regardless of the purpose, however, the fact remains that Tawil does not teach "providing to the identified individual patients a list of certified practitioners, selected from the electronic database, wherein those practitioners who have performed more procedures than others of the practitioners are placed preferentially on the list", as recited in claim 1. Thus, Tawil does not provide the teachings that are missing from DeBruin-Ashton and Falchuk.

Even if, for arguments sake only, one of ordinary skill were to combine the cited references (even though the Examiner has cited no real suggestion or motivation to do so), the combination of references still would not produce the claimed invention. For example, combining DeBruin-Ashton, Falchuk and Tawil might, at best, only produce a list of physicians arranged either randomly or in a listing with physicians new to a health care plan listed in higher proportion.

As is well known by the Examiner, the Office bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness, including clearly identifying each and every element of the claimed invention in the cited references, as well as motivation to combine. MPEP § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, Applicant believes that the Examiner has failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejections of claims 1-5 and 12-13 under 35 U.S.C. §103(a) is respectfully requested.

Claims 6-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Falchuk *et al.* (U.S. 2002/0152096 A1) as applied to claim 1 above, in view of Tawil (U.S. 5,225,976), and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

As set forth above, no reasonable combination of DeBruin-Ashton, Falchuk, and Tawil would teach or suggest the method of claim 1. Kurzius fails to provide the teachings that are missing from DeBruin-Ashton, Falchuk, and Tawil, thereby precluding *prima facie* obviousness.

Applicant respectfully submits that the Examiner's comments regarding Kurzius as non-analogous art are misplaced. As Applicant has previously pointed out, the Kurzius reference is directed to employment candidate recruiting and has nothing to do with referring patients to medical practitioners. As such, not only does Kurzius fail to teach the method of claim 1, but there would be no motivation or suggestion to combine Kurzius with DeBruin-Ashton, Falchuk, and/or Tawil in the first place. Although Examiner has cited to Kurzius at col. 15, lines 45-50 as providing the requisite motivation (see Office Action mailed 4/8/2005, page 9), Applicant is perplexed as to how the cited provision would provide any motivation to combine the cited references, or how any reasonable combination of the cited references would produce the method of claim 1.

Applicant believes that the Examiner has failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejections of claims 6-11 under 35 U.S.C. §103(a) is respectfully requested.

Claims 14, 16-19, 21-22, and 29-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1).

Applicants respectfully submit that the cited references fail to teach each and every element of the claimed invention, thereby precluding *prima facie* obviousness. Similar to the previous discussion, DeBruin-Ashton fails to teach at least the steps of certifying dental practitioners to perform a dental procedure; accessing an electronic database having information comprising performance criteria for each of the group of certified dental practitioners; and providing to the identified individual patients referral lists of certified practitioners, selected from the electronic database, wherein individual practitioners are preferentially placed on the referral lists based on one or more performance criteria, as recited in claim 14. Joao fails to provide the teachings that are missing from DeBruin-Ashton.

As previously made of record, Joao does not teach certifying dental practitioners to perform a dental procedure, as recited in claim 14. In response to Applicant's previous remarks, the Examiner alleges that Joao is "directed to the training of healthcare professionals". Applicants respectfully disagree and again point out that Joao merely mentions the term "dental training" among a voluminous list of possible types of data that may be included in a database of a central processing computer (see, e.g., paragraphs 0156-0180). As the term is not defined in Joao, it is at best unclear exactly what is encompassed by "dental training" according to Joao. As previously submitted, mere reference of the general term "dental training", without more, is insufficient to teach the specific step of certifying dental practitioners to perform a dental procedure, as recited in claim 14.

Applicants further submit that the Examiner has failed to identify any motivation to combine the cited references in the first place. The Examiner has cited to Joao at paragraph 0029 as providing the requisite motivation (see Final Office Action, page 5), but Applicant is unclear as to how the cited provision would provide any motivation to combine the cited references, or how any reasonable combination would produce the method of claim 14.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejections of claims 14, 16-19, 21-22, and 29-30 under 35 U.S.C. §103(a) is respectfully requested.

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1) as applied to claim 14 above, and further in view of Tawil (U.S. 5,225,976).

As set forth above, the cited references of DeBruin-Ashton and Joao, either alone or in combination, fail to teach or suggest in any way each and every element of the method of claim 14. Tawil fails to provide the teachings that are missing from DeBruin-Ashton and Joao. As such, even if combined (although there appears to be no motivation for the suggested combination) the combination of DeBruin-Ashton, Joao, and Tawil would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claim 15 under 35 U.S.C. §103(a) is respectfully requested.

Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1) as applied to claim 14 above, and further in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

As set forth above, the cited references of DeBruin-Ashton and Joao, either alone or in combination, fail to teach or suggest in any way each and every element of the method of claim 14. Falchuk fails to provide the teachings that are missing from DeBruin-Ashton and Joao. As such, even if combined (although there appears to be no motivation for the suggested combination) the combination of DeBruin-Ashton, Joao, and Falchuk would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claim 20 under 35 U.S.C. §103(a) is respectfully requested.

Claims 23-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over DeBruin-Ashton (U.S. 6,014,629) in view of Joao (U.S. 2002/0032583 A1), and in view of Tawil (U.S. 5,225,976), as applied to claims 14-15 above, and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

As set forth above, the cited references of DeBruin-Ashton, Joao and Tawil, either alone or in combination, fail to teach or suggest in any way each and every element of the method of claims 14-15. Kurzius fails to provide the teachings that are missing from DeBruin-Ashton, Joao and Tawil. As such, even if combined (although there appears to be no motivation for the suggested combination) the combination of DeBruin-Ashton, Joao, Tawil and Kurzius would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claims 23-28 under 35 U.S.C. §103(a) is respectfully requested.

Claims 46-49, 51-52, 55-56, and 58 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tawil (U.S. 5, 225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1).

Applicants respectfully submit that the cited references fail to teach each and every element of the claimed invention, thereby precluding *prima facie* obviousness. As discussed above, Tawil fails to teach certifying practitioners to perform a medical procedure or maintaining a patient referral directory in an electronic database having information comprising the number of times each certified practitioner has performed the procedure, wherein certified practitioners selected from the electronic database are prioritized on a list based on the number of times each certified practitioner has performed the procedure, as recited in claim 46.

Falchuk fails to provide the teachings that are missing from Tawil. For example, Falchuk fails to teach certifying practitioners to perform a medical procedure, as recited in claim 46. As

such, even if combined (although there appears to be no motivation for the suggested combination) the combination of Tawil and Falchuk would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claims 46-49, 51-52, 55-56, and 58 under 35 U.S.C. §103(a) is respectfully requested.

Claims 50 and 59 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1) as applied to claims 46 and 58 above, and further in view of DeBruin-Ashton (U.S. 6,014,629).

As set forth above, the cited references of Tawil and Falchuk, either alone or in combination, fail to teach or suggest in any way each and every element of the method of claim 46. DeBruin-Ashton fails to provide the teachings that are missing from Tawil and Falchuk. As such, even if combined (although there appears to be no motivation for the suggested combination) the combination of Tawil, Falchuk, and DeBruin-Ashton would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claims 50 and 59 under 35 U.S.C. §103(a) is respectfully requested.

Claims 53-54 and 57 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tawil (U.S. 5,225,976) in view of Falchuk *et al.* (U.S. 2002/0152096 A1) as applied to claims 46 and 52 above, and further in view of Kurzius *et al.* (U.S. 6,385,620 B1).

As set forth above, the cited references of Tawil and Falchuk, either alone or in combination, fail to teach or suggest in any way each and every element of the method of claim 46. Kurzius fails to provide the teachings that are missing from Tawil and Falchuk. As such,

even if combined (although there appears to be no motivation for the suggested combination) the combination of Tawil, Falchuk, and Kurzius would fail to teach each and every element of the current claims, thereby precluding *prima facie* obviousness.

Applicant believes that the Examiner has clearly failed to carry the requisite burden in establishing *prima facie* obviousness and that this issue is ripe for Appeal.

Accordingly, for the reasons set forth above, withdrawal of the rejection of claims 50 and 59 under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: _____

6/2/2006



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